

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RAYMOND F. RATCLIFF III

Appeal 2007-1302
Application 09/818,003
Technology Center 2100

Decided: May 22, 2007

Before JAMES D. THOMAS, JOSEPH L. DIXON, and
JEAN R. HOMERE, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1 through 41 and 45 through 52, claims 42 through 44 having been canceled by Appellant. We have jurisdiction under 35 U.S.C. §§ 6(b) and 134(a). An oral hearing on this appeal occurred on May 9, 2007.

As best representative of the broadest version of the disclosed and claimed invention, independent claim 1 is reproduced below:

1. A method for sending information to a data processing apparatus for identification of a document having the information using a handheld device capable of communicating with the data processing apparatus, the handheld device having a memory, the method comprising:

providing the document;

capturing the information from the document, wherein the information comprises actual data from the document;

storing the captured information in the memory of the handheld device as document data;

establishing a communications path between the handheld device and the data processing apparatus;

retrieving the document data from the memory of the handheld device; and

sending the retrieved document data from the handheld device to the data processing apparatus through the communications path for identification of the document.

The following references are relied upon by the Examiner:

Neukermans	US 6,229,139 B1	May 8, 2001 (filed Apr. 11, 2000)
Eldridge	US 6,515,988 B1	Feb. 4, 2003 (filed Jul. 17, 1998)
Browning	US 6,707,581 B1	Mar. 16, 2004 (filed Jun. 27, 2000)
Hayakawa	US 6,765,559 B2	Jul. 20, 2004 (filed Mar. 20, 2001)
Hochendoner	US 6,771,568 B2	Aug. 3, 2004 (filed Jan. 12, 2001)

Because of the cancellation of claims 42 through 44, the rejection of these claims under 35 U.S.C. § 101 is moot. Otherwise, all claims on appeal stand rejected under 35 U.S.C. § 103. In a first stated, basic rejection as to claims 1, 2, 7 through 9, 12 through 19, 21 through 23, 30, 31, 33 through 42, 44, and 45 through 52, the Examiner relies on Eldridge in view Neukermans. In a second stated rejection, the Examiner adds Hayakawa to this basic rejection as to claims 3 through 6 and 24 through 27. In a third stated rejection, the Examiner adds Browning to the first rejection as to claims 10, 20, 28, 32, and 43. Lastly, in a fourth stated rejection, the Examiner adds Hochendoner to the first rejection as to claims 11 and 29.

Rather than repeat the positions of the Appellant and the Examiner, reference is made to the Brief and Reply Brief for Appellant's positions, and to the Answer for the Examiner's positions.

OPINION

We affirm-in-part.

At the outset, we note that each of independent claims 1, 12, 16, 22, 30, 34, 38, 45, 47, 48, and 49 of the claims on appeal stand rejected under the first stated rejection relying upon Eldridge in view of Neukermans. Inasmuch as pages 8 through 13 of the principal Brief on appeal treat the subject matter of independent claims 1 and 45 collectively, we will address the arguments as to these claims, the rejection which we affirm. As to each of the other remaining independent claims on appeal, we reverse the rejection of them and their corresponding dependent claims.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of

obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1996). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, No. 04-1350, slip op at 14 (U.S., Apr. 30, 2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

As noted earlier, claim 1 is representative of the subject matter of independent claims 1 and 45 on appeal. Since we consider the Examiner’s views in the statement of rejection of claim 1 at pages 5 and 6 of the Answer and of claim 45 at pages 19 and 20 of the Answer as essentially complying with the above precedent, we sustain the rejection of representative independent claim 1 on appeal for the reasons set forth by the Examiner in the Answer, including those responsive remarks at pages 28 through 31 of the Answer, as slightly modified here. It appears to us both the Examiner and Appellant have not appreciated one significant teaching in Eldridge.

Because Neukermans plainly scans a document, it contains actual document data. As to Eldridge, we do not agree with Appellant’s urging at page 9 of the principal Brief on appeal that this reference does not contain actual document data. Figure 3B of Eldridge relates to the data components of his token with the focus in figure 3B being that it relates to his token for a

document. In addition to the document identifier 46, the document parameters 48 include the document name 482, where the discussion of this figure at column 8, lines 9 through 26 plainly indicates that this document name component includes the title of the document. In this respect only then, the Examiner's views expressed in the Answer that Eldridge does not disclose the capture of actual data of a document is misplaced. In this respect as well, we note, as indicated by the remarks from the panel during the oral hearing, that the feature of capturing the information from the document in representative independent claim 1 on appeal is not recited in the claim to be done by the handheld device itself. Appellant's remaining arguments in the principal Brief on appeal appear to hinge in part upon these incorrect assertions with respect to Eldridge.

Appellant's view at page 10 of the principal Brief on appeal that there is no suggestion in Eldridge to replace the tokens with actual document data and that there is no suggestion in this reference to add actual document data to the token is misplaced in two respects. First, the reference does teach that the tokens contain actual document data in the figure 3B version of the tokens. Moreover, the Examiner's position has not asserted that Eldridge teaches this even though we have determined that it does. Likewise, Eldridge can hardly be said to teach away from sending actual document data as urged at the bottom of page 10 of the principal Brief on appeal. Similarly, the view expressed at the bottom of page 11 of the principal Brief that the entire purpose of Eldridge is to avoid storing document data is incorrect in view of this teaching we have noted here. Lastly, the view at page 12 of the principal Brief on appeal that the token in Eldridge is not

analogous to document data is clearly misplaced since it does teach the claimed document data is within its tokens. Appellant's principal Brief on appeal does not contest the Examiner's other correlations at page 5 of the Answer with respect to the subject matter taught in Eldridge and the other steps recited in claim 1 on appeal. As indicated by the panel during the oral hearing, it appears plain that the reference to Eldridge alone would have rendered obvious the subject matter of representative claim 1 on appeal.

As also indicated to Appellant's representatives during oral hearing, Neukermans alone also would have rendered obvious the subject matter of claim 1 on appeal. The scanner 100 in this reference is connected to or an integrated part of a so-called PDA as in Eldridge. Note the showing in figure 5 as well. As noted by the Examiner with respect to the middle of column 1 and the paragraph at column 3, lines 51 through 60, actual document data is captured by the scanner associated with the PDA, where the information thus scanned is in the form of document data that is stored which is plainly communicated on a path either to an associated notebook or laptop computer or over a network.

Claim 1 recite in its preamble that the data processing apparatus is "for identification of a document" and that the sending of a document data at the end of claim 1 on appeal is "for identification of the document." As indicated to Appellant's representatives during the oral hearing, there is no positively recited step of conducting this function of identification in claim 1 on appeal. As such, the mere sending of the document data in both Neukermans and Eldridge obviously would have been considered by an artisan to occur "for" any purpose, for any end use, including identification

of the document. In fact, this is one of the stated purposes of the token communications scheme in Eldridge anyway.

Additionally, we sustain the stated rejection of the Examiner relying upon the combination of teachings and showings in Eldridge and Neukermans as set forth by the Examiner initially in the statement of the rejection of representative independent claim 1 at page 6 of the Answer and greatly expanded upon beginning at page 28 of the Answer. At a minimum, the teachings of Neukermans would have enhanced the already comprehensive capability of Eldridge, even to the point of adding a new kind of token data from the teachings of Neukermans to the system of Eldridge as best explained by the Examiner at page 29 of the Answer.

We do not agree with Appellant's observation at page 11 of the principal Brief that the addition of the teachings of Neukermans to those of Eldridge would have destroyed the apparatus of Eldridge for its intended purpose. First, the proper consideration of applied prior art within 35 U.S.C. § 103 is to combine or not to combine teachings of the respective reference rather than to combine structures. Even so, the addition of a structural element as a scanner in the PDA of Eldridge clearly would have been an obvious enhancement to the structural system and functional capabilities of Eldridge. As noted at the middle of page 10 of the principal Brief on Appeal, we are well aware of the purpose of the tokens of Eldridge as indicated at column 1 of this reference, that the token may be utilized to communicate the transmission of document information rather than a lengthy document itself. Since document data per se is already transmitted within the document token figure 3B of Eldridge, the addition of the small

documents, including the representative business card of Neukermans, to the capabilities of Eldridge would not have destroyed the capabilities of Eldridge since a lengthy document is not transferred.

It is believed that these remarks essentially address those additional comments made by Appellants at pages 3 and 4 of the Reply Brief as to representative independent claim 1 on appeal. Based upon the teachings in Eldridge that we have outlined with respect to its document token's ability to convey a document title, the Examiner's remarks at page 25 of the Answer relating to the ability to identify a passage of a document and therefore the document itself may not fairly be considered to be a new ground of rejection as urged at the bottom of page 3 of the Reply Brief. Appellant's own Specification regarding the nature of the information from a document plainly encompasses the Examiner's observation as well as the title of a document taught in Eldridge.

In view of the foregoing, we have sustained the rejection of independent claim 1 as representative of independent claim 45 as well. Therefore, since no arguments are presented to us regarding their respective dependent claims, the rejection of them is also affirmed.

As indicated earlier in this opinion, we do not sustain the Examiner's rejection of the other independent claims on appeal. In distinction to the subject matter of representative independent claim 1 on appeal, claim 12 recites the extraction of a portion of a document data "as scanning data" which is used in a comparing step to be compared with reference data leading to the selection, based upon a match of this comparison, of a

reference document itself. Each of the other independent claims on appeal contains corresponding features.

Neukermans does not teach the use of his scanning data for purposes of a comparing function with reference data for the identification of a document. The Examiner relies upon these capabilities in Eldridge. Specifically, the Examiner continues to make reference to the teaching at the middle of column 2 of this reference for the compare capability of claim 12 in the Examiner's positions with respect to the rejection. As to Eldridge, we are generally in agreement with Appellant's observations beginning at page 14 of the principal Brief on appeal relating to deficiencies and the teachings of Eldridge as to the disputed features in this claim as we have just outlined. Eldridge does not disclose, teach or even suggest using document or scanned data in a comparing function with reference data for purposes of identifying a document. One of the major functions of the tokens in Eldridge is to use them as a part of a search request which is sent to a search engine for retrieval of the document itself. As revealed at the bottom of the abstract, the middle of column 1, the middle of column 2 and the top half of column 5, the comparison function in Eldridge relied upon by the Examiner is with respect to comparing URL addresses and not document data per se, such as the title of the invention we made reference to earlier that is taught in Eldridge. Therefore, since we have found that the teachings of Eldridge and Neukermans were properly combinable within 35 U.S.C. § 103, the combined teachings would not have taught or suggested to the artisan the essential comparing function recited in independent claims 12, 16, 22, 30, 34, 38, 47, 48, and 49 on appeal.

In conclusion, we have sustained the Examiner's rejections of claims 1 through 11, 45, and 46 within 35 U.S.C. § 103, but have reversed the rejections of the remaining claims on appeal also rejected under 35 U.S.C. § 103. Therefore, the decision of the Examiner rejecting claims 1 through 41 and 45 through 52 under 35 U.S.C. § 103 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. §1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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